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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/028,416

12/21/2001

Simon Cawley

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22886

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05/12/2006

AFFYMETRIX, INC

ATTN: CHIEF IP COUNSEL, LEGAL DEPT.

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SANTA CLARA, CA 95051

EXAMINER

MARTINELL, JAMES

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,416

Applicant(s)

CAWLEY ET AL.

Examiner

James Martinell

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-22, 24-38 and 40-48 is/are rejected.
- 7) ☒ Claim(s) 7, 23, and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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Claims 14 and 27 are objected to because of the following informalities. This objection is made in order to expedite prosecution of the instant application.

- (a) In claim 14, line 2, a comma was deleted just in front of "wherein" without notation. Thus, claim 14 as it appears in the amendment filed February 24, 2006 is not an original claim. In any response, applicants are required to cancel the claim, rewrite it as a new claim, and appropriately amend any claims that depend from claim 14.
- (b) In claim 27, last line, "a" was changed to "the" without notation. Thus, claim 27 as it appears in the amendment filed February 24, 2006 is not an original claim. In any response, applicants are required to cancel the claim, rewrite it as a new claim, and appropriately amend any claims that depend from claim 27.

Appropriate correction is required.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 9-16, 25-32, and 41-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague and indefinite.

- (a) The recitation of "evaluating the probability" (claims 9, 25, and 41) is vague and indefinite because it is not clear what is meant by the step. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed December 19, 2003, page 3, item (k)). Applicants' assertion (response filed June 21, 2004, page 19) is not convincing because applicants merely assert that the method is well known in the art and is described in numerous statistical textbooks without proving for the record any evidence to support such a conclusion.
- (b) The recitation of "using a gamma function" (claims 12, 28, and 44) is vague and indefinite because it is not clear what is meant by the phrase. This rejection is

repeated for reasons already of record (*e.g.*, Office action mailed December 19, 2003, page 4, item (p)). Applicants' assertion (response filed June 21, 2004, paragraph bridging pages 20-21) is not convincing because applicants merely assert that the method is well known in the art and is described in numerous mathematical textbooks without proving for the record any evidence to support such a conclusion.

- (c) The recitation of "to produce a density distribution which places a majority of its weight on the bases" (claims 12, 28, and 44) is vague and indefinite because it is not clear what is meant by the passage. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed December 19, 2003, page 4, item (q)). It is not seen how the amendment makes the claims any more clear.
- (d) The recitation of "wherein the first term . . . Markovian probabilities" (claims 14, 30, and 46) is vague and indefinite because it is not known what is meant by the passage. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed December 19, 2003, page 4, item (s)). Applicants' assertion (response filed June 21, 2004, page 22) is not convincing because applicants merely assert that the method is well known in the art and is described in numerous statistical textbooks without proving for the record any evidence to support such a conclusion.
- (e) The recitation of "base b . . . 3' UTR sequences" (claims 15, 31, and 47) is vague and indefinite because the passage is not understood. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed December 19, 2003, page 4, item (u)). Applicants' assertion (response filed June 21, 2004, page 22) is not convincing because applicants merely assert that the claim language is clear.

Claims 1-6, 8, 17-22, 24, 33-38, and 40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Beaudoin et al (Genome Res. 10: 1001 (July 2000)). This rejection is repeated for reasons already of record (*e.g.*, Office action mailed December 19, 2003, paragraph bridging pages 4-5). Applicants' arguments (response filed June 21, 2004, page 23) are not convincing. Beaudoin et al does

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teach searching for polyadenylation signals in the 3' UTR of nucleic acid sequences (*e.g.*, see the last paragraph on page 1008.

Claims 7, 23, and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719.

The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

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OFFICIAL FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


James Martinell, Ph.D.
Primary Examiner
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5/3/06